

REMARKS

Claims 1-7 are pending. Claim 1 has been amended. Claims 41-45 have been withdrawn without prejudice to or disclaimer of the underlying subject matter. Support for the amended claim can be found throughout the specification and in the claims as originally filed, for example at page 12, lines 14-23. Upon entry of this amendment, claims 1-5, 8-11, and 38-45 will be pending. No new matter enters by way of these amendments.

I. Restriction/Election

Applicants acknowledge the finality of the restriction requirement but maintain their traversal as set forth in Applicants' Response to Restriction Requirement filed March 10, 2005. Applicants maintain that the complete examination would be handled most expeditiously by treating all of the claims as a single entity and such treatment would impose no serious burden upon the examiner.

Applicants reiterate that no serious burden is created for the Examiner by simultaneously examining all of the claims together in a single application. The relationship in the subject matter between Group I and Group II is amenable to simultaneous examination of the subject matter of the two groups. Indeed, the Office acknowledges that "the Groups are related in that each is directed to a product comprising a nucleic acid of SEQ ID NO: 1." Office Action mailed March 7, 2005 at page 2. As such, there is a close relationship between the subject matter of these sets of claims. It is respectfully believed that there would be no serious burden on the Examiner to examine all of the claims together at this time.

The Examiner argues that “a search for cells, animals, or other transgenic organisms requires a search of the prior art not required for a nucleic acid sequence, per se...[and] a search for any single Group requires a search of nonpatent literature and foreign patent databases as well as US patents and publications” Office Action at page 2. The Examiner concludes that “[f]or these reasons, the examiner maintains that [it] would be burdensome to search for both nucleic acid sequences and transgenic organisms.” *Id.* As previously discussed, the TC 1600 Restriction Training Materials further support such a grouping of claims. *See, e.g.,* TC Restriction Training Materials, 1630/1640/1650 Example 1, pages 24-37 (August 2004). The Office’s Training Materials acknowledge that polynucleotides, vectors and host cells can be grouped together for examination without a serious burden on the Examiner. *See, e.g., Id.* at page 27. The Examiner has provided no support for the proposition that a search of all of the claims would pose a serious burden on the Office.

As such, Applicants submit that restriction in this case is improper and therefore request withdrawal of the requirement for restriction between Groups I and II.

Moreover, as claims 38 and 39 have been indicated as allowed by the Examiner, Applicants respectfully request that claims 40-45 be rejoined with these claims.

II. Rejections under 35 U.S.C. § 102

Claim 1 stand rejected under 35 U.S.C. § 102(a) as allegedly being “anticipated by WING et al. (NCBI Acc =. No. AZ134591), as supported by MEINKOTH et al (Analyt. Biochem. (1984) vol. 138, pp. 267-284).” Office Action at page 4. According to the Examiner, “WING teaches a nucleic acid sequence which is only 20.8% identical,

but 94.7% similar over its length to instant SEQ ID NO: 1.” *Id.* Using the equation disclosed in Meinkoth, the Examiner concludes that “the T_m for 0.15M salt - 61.9° and the T_m for 0.9M salt = 74.8°C ... the nucleic acid of WING would be expected to hybridize to instant SEQ ID NO: 1 under the range of salt and temperature which are ‘low stringency condition’, and claim 1 is anticipated.” *Id.*

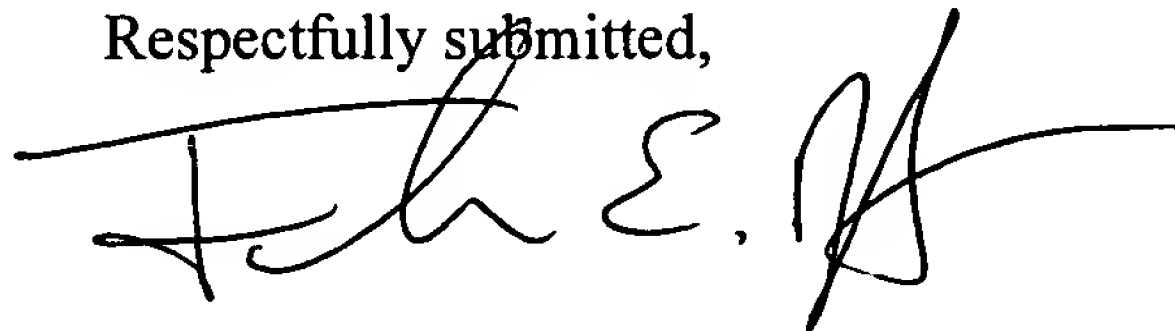
Although Applicants disagree with the Examiner’s application of the Wing *et al.* reference, in order to facilitate prosecution, Applicants have amended claim 1, rendering this anticipation rejection moot. Based on the foregoing, Applicants respectfully submit that the rejection of Claim 1 on the basis of Wing *et al.* in light of Meinkoth has been rendered moot. Reconsideration and withdrawal of this rejection under 35 U.S.C. §102(a) is respectfully requested.

Accordingly, for at least the foregoing reasons, the rejection of claims 1 and 23-24 under 35 U.S.C. § 102(b) is improper. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the present application is now in condition for allowance, and notice of such is respectfully requested. The Examiner is encouraged to contact the undersigned should any additional information be necessary for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "T. E. Holsten" followed by a stylized mark that likely represents "David R. Marsh".

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